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REMARKS

Claims 1-15 were originally presented in the subject application. Claims 1-15 were cancelled and claims 16-47 added in a Response dated August 4, 2004. Claims 16, 20, 28, 33, 34, 36, 40, 41 and 47 were amended in a Preliminary Amendment filed April 8, 2005, with a Request for Continued Examination. No claims have herein been amended, added or canceled. Therefore, claims 16-47 remain in this case.

Applicants respectfully request entry of these remarks, and reconsideration and withdrawal of the sole ground of rejection.

35 U.S.C. §103 Rejection

The Office Action rejected claims 16-47 under 35 U.S.C. §103, as allegedly obvious over Findley, Jr. et al. (U.S. Patent No. 5,979,773), hereinafter "Findley," in view of Sloan (U.S. Patent No. 6,179,205). Applicants respectfully, but most strenuously, traverse this rejection.

As an initial matter, and explained more fully below, Applicants submit that Sloan teaches away from card holder involvement in verification. As such, Applicants submit Sloan is improperly cited against the claims of the present application. Moreover, given the allegation in the final Office Action that Findley teaches card holder verification, Applicants submit that such opposite teachings would not lead one skilled in the art to combine Sloan with Findley, and that Sloan is improperly combined with Findley.

Claim 1 recites, for example, that "if the checking indicates no trusted association, then involving the holder of the card in performing card holder verification."

In stark contrast, Sloan teaches (emphasis added):

Some smart card companies, such as Mondex International, currently utilize a wallet which can lock and unlock a smart card. The locking and unlocking mechanism utilizes a personal identification number (PIN) to ensure authenticity of the lock or unlock request. However, **many people prefer not to use PINs. It is a nuisance to have to memorize a PIN, particularly if the person already has several PINs memorized. Additionally, a particular PIN can be forgotten or**

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**confused with another PIN. Further, the need for a PIN requires that the "electronic wallet" device has at least a numeric key pad to enter the PIN. This is undesirable for some users who do not want to carry a relatively bulky wallet with them.**

**What is needed is a system and method for automatically ensuring authenticity for locking and unlocking an application in a smart card which does not require the user to memorize a PIN. Preferably, the system and method may be implemented using a device which does not require the use of a bulky and expensive keypad.**

**Thus, Applicants submit that Sloan teaches away from card holder involvement in the verification process, and thus, teaches away from the presently claimed invention. Moreover, given the Office Action allegation that Findley teaches card holder involvement, Applicants submit these opposing teachings have two consequences. First, one skilled in the art would not be motivated to combine Sloan with Findley, and second, the combination of Sloan with Findley is improper.**

**Moving on to the substantive rejection, Findley teaches a dual card system where an access card is necessary to access data on an identity/user card. See, e.g., Findley at column 3, lines 42-51. Each card is given to different people, the access card being given to a system operator and the identity/user card being given to a user. Findley teaches at column 4 that access cards can be made to expire and/or use a PIN/password.**

**Applicants submit Findley fails to teach or suggest conditional card holder verification as claimed. The disclosure in column 4 of Findley regarding access cards using a PIN/password is not conditioned on anything, let alone the claimed trusted association between the device and the card. A PIN/password is either implemented as part of the Findley system, or it is not. There is nothing conditional about it. With regard to access card expiration, Findley simply generally teaches that reactivation following system sponsor/operator procedures is necessary. There is no disclosure, teaching or suggestion as to what the reactivation procedure would be.**

**Moreover, Applicants submit that one of ordinary skill would not view a date for expiration as being a trusted association. Examples of a trusted association given in the application (and claimed) include checking a device ID against that stored on the card, and checking a card ID against that stored on the device. A mere expiration date has no trust aspect**

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in the sense of one entity knowing or recognizing another. However, even if an expiration date were somehow held to read on a trusted association, Applicants submit access card holder verification is not taught, only reactivation according to an undescribed procedure with nothing more.

Even ignoring the above remarks regarding Sloan teaching away from user involvement, Applicants submit Sloan does not overcome the deficiencies of Findley. Similar to Findley, Sloan fails to disclose, teach or suggest a conditional card holder verification procedure in which intervention is suppressed, if there is a presence of a trusted association, but intervention is used, if such a trusted association does not exist. That is, there is no disclosure, teaching or suggestion in Sloan of suppressing involvement of a card holder in performing card holder verification in the event there is a trusted association, and if there is no trusted association, going forward with card holder verification, but requiring card holder intervention.

In Sloan, the smart card device either issues an unlock command, if it has cached a password for the card identifier, or indicates that it is unable to unlock the application on the smart card if it has no entry for the card. It does not ask the user for authentication information, if no password is found, as claimed by Applicants. Thus, Applicants respectfully submit that Sloan does not disclose, teach or suggest one or more aspects of Applicants' claimed invention.

Since both Findley and Sloan fail to describe, teach or suggest the conditional aspect of Applicants' claimed invention in which involvement of the card holder in performing card holder verification is suppressed, if a trusted association is present, and card holder intervention is used in the card holder verification, if there is no trusted association, Applicants respectfully submit that the combination of Findley and Sloan fails to teach or suggest one or more aspects of the present invention.

The final Office Action also maintains generally that it is well known in the art that when checking indicates no trusted association, involving the card holder to perform verification. In support, the final Office Action cited to Creekmore (U.S. Patent No. 4,187,498) at column 6. lines 39-67, and generally to Beuk et al. (U.S. Patent No. 5,446,266). Applicants respectfully disagree for the reasons detailed below.

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Creekmore discloses a check verification system that includes an ID card. However, the checking that is being done in Creekmore is not checking for a trusted association between a device and a card usable with the device. Instead, Creekmore checks for card usability, i.e., checks to see if the card is a check cashing card. No trusted association as claimed is checked. Moreover, Creekmore teaches that an ID number is always requested for check cashing cards.

Similar to Findley, Beuk et al. discloses a dual card system, one having a system code and the other a security code. Any card with the correct security code can operate the apparatus, and the card with the system code can change the security code on the security card. If the security code is not correct, the apparatus cannot be used. The final Office Action cites to no specific section of Beuk et al., and Applicants could find no provision for conditional card holder involvement in verification.

Therefore, Applicants submit that claim 16 cannot be rendered obvious over Findley in view of Sloan.

Each of independent claims 33, 34, 40, 41 and 47 contains, in some form, limitations similar to that argued above with respect to claim 16. Thus, the remarks made above with respect to claim 16 are equally applicable thereto. Therefore, each of claims 33, 34, 40, 41 and 47 also cannot be made obvious over Findley in view of Sloan.

Applicants submit that the dependent claims are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For example, claim 19 recites that suppressing involvement of the user of the card in card holder verification comprises performing card holder verification hidden from the holder of the card. The final Office Action does not specifically address claim 19. However, Applicants could find no disclosure, teaching or suggestion of card holder verification hidden from the card holder. As remarked above, Findley mentions PIN/password protection and card expiration, but provides no details. Of course, user entry of a PIN or password is not hidden from the card

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holder, and for card expiration, Findley is simply silent on what the reactivation procedure is, or who would be doing it. Sloan does not remedy the shortcomings of Findley in this regard.

Therefore, Applicants submit that claim 19 cannot be rendered obvious over Findley in view of Sloan.

Claims 35, 42 contain a limitation similar to that argued above with respect to claim 19. Thus, the remarks above apply equally thereto, and claims 35 and 42 also cannot be obviated over Findley in view of Sloan.

As another example, claim 20 depends from claim 19, and recites that the hidden verification comprises automatically obtaining a PIN of the holder of the card and verifying the PIN without intervention of the card holder. Against claim 20, the final Office Action cites to Findley at column 7, lines 14-67. However, that section teaches that identity information is read and displayed from an identity card if the access and identity cards are compatible as to accessible fields of data. There is no PIN involved, and, in any case, the claimed association is between the device and the card, not two cards. Against claim 20, the final Office Action next cites to Findley at column 2, lines 1-30. However, that section teaches comparing secured area access data on the two cards to determine if the identity card has access to a given area. Again, no teaching regarding a PIN or card *holder* verification, much less verifying a PIN hidden from and without intervention of the user. Next, the final Office Action cites to Findley at column 2, lines 35-58. However, that section teaches that the access card can add/modify digital identity data regarding the user. Again, nothing regarding a PIN, card holder verification, or obtaining/verifying PIN hidden from and without intervention of the user. Finally, the final Office Action cites to Findley at column 7, lines 10-20. However, that section merely teaches that identity cards contain digital identity data regarding the user.

Therefore, Applicants submit that claim 20 cannot be rendered obvious over Findley in view of Sloan.

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Claims 28, 33, 36, 40, 43 and 47 contain a limitation similar to that argued above with respect to claim 20. Thus, the remarks above apply equally thereto, and claims 28, 33, 36, 40, 43 and 47 also cannot be obviated over Findley in view of Sloan.

As still another example, claim 22 recites checking for the trusted association comprises comparing a card identifier stored on the card with one or more card identifiers stored in the device. Against claim 22, the final Office Action cites to the same sections of Findley as that discussed above regarding claim 20. The teaching of each cited section is discussed above, and Applicants submit that none teaches or suggests comparing a card identifier on the card with one or more stored in the device. At most, Findley compares access information stored on two cards, not a card and a machine, and not a card identifier.

Therefore, Applicants submit that claim 22 cannot be rendered obvious over Findley in view of Sloan.

Claim 38 contains a limitation similar to that argued above with respect to claim 22. Thus, the remarks above apply equally thereto, and claim 38 also cannot be obviated over Findley in view of Sloan.

### CONCLUSION

Applicants submit that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations. The dependent claims specifically addressed are merely examples.

Applicants acknowledge the references cited in the Office Action, but not substantively applied. However, Applicants submit that the pending claims are patentable thereover as well.

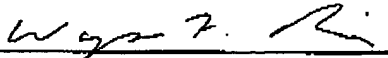
For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly request entry of these remarks and allowance of claims 16-47.

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If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,

  
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Dated: January 27, 2006.

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